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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,634	09/28/2001	Walter Kuzma Stepanenko	10541/296	5066

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09/05/2002

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EXAMINER

SAWHNEY, HARGOBIND S

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 09/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/966,634

Applicant(s)

STEPANENKO ET AL.

Examiner

Hargobind S Sawhney

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 23-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 20-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22, drawn to a combination- an integrated light and accessory assembly - classified in class 362, sub-class 240.
- II. Claims 23-29, drawn to sub-combination – method of manufacturing a printed circuit board and an integrated light assembly-, classified in class 438, subclass 455.

2. Inventions II and I are related as combination and sub-combination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the sub-combination as claimed for patentability, and (2) that the sub-combination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the sub-combination as claimed. Therefore, patentability of the combination – an integrated light and accessory assembly - does not rely on the method of manufacturing a printed circuit board and an integrated light assembly claimed in claims 23-29. Further, the sub-combination- printed circuit board- has separate utility such as its use for illuminated display including LCDs, microcomputers and telephone displays.

Art Unit: 2875

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation on August 25, 2002, Mr. David W. Okay made an election with traverse to prosecute the invention of invention I, claims 1-22, and claims 23-29 were withdrawn from further consideration as being drawn to a non-elected invention. Thus, only claims 1-22 have been examined for the instant application.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

5. The disclosure is objected to because of the following informalities:

Page 1, line 7, missing information of the referenced application needs to be provided.

Appropriate correction is required.

### ***Claim Objections***

1. Claims 1-19, are objected to because of the following informalities:
  - Claim 1, line 8, "module" needs to be revised as – control module – to make it consistent with the limitation "the at least one control module" recited in line 11;
  - Claim 1, line 13, "controller" needs to be revised as –the control module-- to make it consistent with the limitation "the at least one control module" recited in line 11;
  - Claim 1, line 12, "adapted to provide illumination" should be revised as – illuminating when being actuated;
  - Claim 1, line 12, "adapted to receive electrical power" should be revised as – receiving power;
  - Claim 6, line 2, "the substrate" needs to be revised as – the insulator -- to make it consistent with the limitation "insulator" recited in line 3 of the base Claim 1;
  - Claim 14, lines 11, "at least one control module" needs to be revised as - the electronic module-- – to make it consistent with the limitation "an electronic module" recited in line 8;

- Claim 15, line 2, "the integrated light and accessory assembly" needs to be revised as -- the lamp--;

Claims 2-19 are necessarily objected because of their dependency on the objected base Claim 1.

The instant application has been examined considering the claims including the above-indicated revisions suggested by the examiner.

2. Claim 20-22 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 26 and 27. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-7,9-12,14-17 and 19, are rejected under 35 U.S.C. 102(e) as being anticipated by Pederson (U.S. Patent No. 6,367,949).

Regarding claims 1-7,9-12,14-17 and 19, Pederson (U.S. Patent No. 6,367,949) discloses an integrated light and accessory assembly (Figure 15B) comprising:

- an insulator 14 (Figure 2, column 12, line 23) – because its inherent insulating encasing, the LED circuit board 1530 is considered herewith as an insulator – bearing reflectors 18 (Figure 2, column 11, line 29) providing illumination;
- a conductors 54 (Figure 2, column 12, lines 36-40) being connected to the insulator 14, and receiving power;
- a plurality of lamps (LEDs) 16 (Figure 2, column 11, line 28) being connected to the conductor 54 (Figure 2), and illuminating when being actuated;
- a control module 58 (Figure 2, column 12, line 54-58) mounted on the insulator 14 and connected to the conductor 54 (Figure 2);
- a housing 36 (Figure 2, column 11, lines 59 and 60) enclosing the reflectors 18, conductor 54, lamps 16 and control module 58 (Figure 2)
- the lamps 16 being a hazard warning lamp (column 1, lines 10 and 11), and being inherently releasably mounted, because of a need for replacement, inside the housing;
- the control module 58 controlling lighting provided by LEDs 16 (column 12, line 56, column 13, lines 34 and 35 and column 14, lines 16-21);
- a power storage device (Figure 2, column 13, lines 24-27);

- a switch (not shown) inherently provided either on the main control panel of the vehicle or locally on the housing of the device; and
- a light detector sensor mounted on the insulator coupled to the control module 58 (not shown, Figure 2, column 20, lines 60-65).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pederson (U.S. Patent No. 6,367,949) in view of DeLine et al. (U.S. Patent No. 6,124,886).

Regarding Claims 8 and 18, dependent on Claims 6 and 16 respectively, Pederson does not teach an integrated light and accessory assembly comprising a transmitter.

On the other hand, DeLine discloses a rearview mirror lamp assembly 500 (Figure 47) comprising various devices a light and a toll transponder (transmitter) 5081 (Figure 47, column 30, line 62).



Art Unit: 2875

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the integrated light and accessory assembly of Pederson by providing the a toll transponder coupled to the module as taught by DeLine for benefits and advantages of size reduction and economical electronic packaging.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pederson (U.S. Patent No. 6,367,949) in view of Okawa (Japanese pattern No. JP 07-142820).

Pederson does not teach an integrated light and accessory assembly comprising an additional layer of insulation mounted to a conductor, and a ground or return mounted to the additional layer.

On the other hand, Okawa (Japanese pattern No. JP 07-142820) discloses a laminated substrate for integrated light and accessory assembly comprising a multi-layer circuit board 1 (Figure 4) bearing LEDs 7, and including a plurality layers of insulation mounted on a conductor 1'a, 1'b, 1'c (Figure 4) – unit printed wiring plates -. Although, Okawa does not particularly discloses uses of these insulated conductor layers, obviously one of these conductors could be adapted for return.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the integrated light and accessory assembly of Pederson by providing the additional layer of insulation mounted on a conductor taught by Okawa for benefits and advantages of size reduction and economical electronic packaging.

Art Unit: 2875

**Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Suzuki et al. (U.S. Patent No. 5,580,156) and Bell et al. (U.S. Patent No. 6,400,308 B1) each discloses an integrated light and accessory assembly comprising some of the features, including an insulator (printed circuit board), a reflector, conductors mounted on the insulator and a modulator, claimed by the applicant.

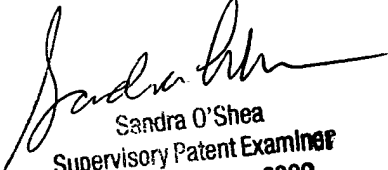
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S, Sawhney whose telephone number is 703-306-5909. The examiner can normally be reached on 7:30 - 5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7724 for regular communications and 703-308-8303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2956.

HSS

8/28/2002

  
Sandra O'Shea  
Supervisory Patent Examiner  
Technology Center 2800